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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,187	07/31/2007	Toru Kimura	01115_1013	4887
30671 7590 01/05/2011 DITTHAVONG MORI & STEINER, P.C. 918 Prince Street Alexandria, VA 22314				
EXAMINER JOHNSON, CONNIE P				
ART UNIT		PAPER NUMBER		
1722				
NOTIFICATION DATE		DELIVERY MODE		
01/05/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

Office Action Summary

Application No.

10/586,187

Applicant(s)

KIMURA ET AL.

Examiner

CONNIE P. JOHNSON

Art Unit

1722

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 2-8,10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. The remarks and amendment filed 12/3/2010 have been entered and fully considered.
3. Claims 1-14 are presented.
4. Claim 7 is amended.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 9, 12, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake et al., U.S. Patent Publication No. 2002/0136979 A1 in view of Endo et al., U.S. Patent Publication No. 2004/0224525 A1.

Miyake teaches a resist material on a substrate with an upper and lower recording layer. The upper recording layer comprises an alkali-soluble resin (page 9, [0087]). The upper recording layer may also comprise a solvent (page 16, [0190-0191]). The solvents comprise propanol, which is a monovalent solvent with 6 or less carbon atoms as in instant claim 13 (page 16, [0082]). Therefore, the components of the upper

recording layer would not cause intermixing with the photoresist film. With regards to the recitation in claim 1, "for being applied to coat on a photoresist film when using an immersion exposure device which is irradiated through water provided between a lens and the photoresist film...being dissolved in a subsequent developer" is a product by process limitation. Product by process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (MPEP 2113). The recitation, "forming a water-stable film during irradiation" is intended use and does not add positive recitation to the claim. The recitation in claim 9, "dissolving an alkaline solution during development using the alkaline aqueous solution" is intended use and does not add positive recitation to the claim. Miyake teaches a patter-forming method. However, Miyake does not teach forming a pattern by immersion exposure with water.

Additionally, Endo teaches an immersion exposure method for a resist wherein the resist material is on a substrate and comprises a resist layer and a topcoat layer. The pattern is formed by exposing the resist material to irradiation wherein water is used as the immersion fluid on top of the topcoat layer. The resist is developed to form the pattern (pages 2-3, [0033-0035]). It would have been obvious to one of ordinary skill in

the art to use immersion exposure in the composition of Miyake because immersion exposure is well known to improve resolution of the pattern (page 1, [0003]).

Response to Arguments

7. Applicant's arguments filed 12/3/2010, with respect to the rejection(s) of claim(s) 1-4 and 9 under 102(e) over Li and claims 1, 3 and 5-12 under 103(a) over Li have been fully considered and are persuasive. Therefore, the rejections have been withdrawn.
8. Claims 2-8, 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CONNIE P. JOHNSON whose telephone number is (571)272-7758. The examiner can normally be reached on 7:30am-4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Connie P. Johnson
Examiner
Art Unit 1795

/Shean C Wu/
Primary Examiner, Art Unit 1722